

REMARKS

Claims 21-23, 25-27 and 32-34 stand rejected under 35 U.S.C. § 102 as being anticipated by JP '517. This rejection is respectfully traversed for the following reasons.

Even assuming *arguendo* that Example 4 of JP '517, which was relied on by the Examiner in the outstanding Office Action, discloses forming a solid organic conductive material on the surface of the positive electrode, it does so *after* first placing the separator between the positive and negative electrode, rather than before as in the present invention (*see, e.g.*, Figure 2a-g of Applicants' drawings). Moreover, Examples 1-3 of JP '517 disclose only forming the solid organic conductive material on the separator before it is placed between the electrodes rather than on the surface of the positive electrode.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that JP '517 does not anticipate claim 21, nor any claim dependent thereon.

Claims 29 and 30 stand rejected under 35 U.S.C. § 103 over JP '517 in view of Kobayashi et al., and claim 24 stands rejected under 35 U.S.C. § 103 over JP '517 in view of Yoshimura et al.. These rejections are respectfully traversed for the following reasons. It is respectfully submitted that even assuming *arguendo* proper, the proposed combination does not disclose the claimed combination for the same reasons discussed above with respect to claim 21 (the Examiner does not rely on Kobayashi et al. nor Yoshimura et al. to cure the deficiencies of JP '517). As is well known, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 180 USPQ 580 (CCPA 1974). Under

Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 21 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

For example, it is respectfully submitted that the Examiner's asserted motivation to make the respective combinations is improper. That is, the Examiner merely states that the motivation to make the combinations is "to use a conventional material for the same purpose." However, this motivation does not suggest the *desirability* of the combination, but only the possibility, which is not sufficient for purposes of § 103. As is well known, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, a statement that modifications of the prior art to meet the claimed invention would have been [obvious] because the references relied upon teach that all aspects of the claimed invention were *individually* known in the art is *not* sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)). In the instant case, the Examiner has not provided the requisite objective evidence *from the prior art* that the specific modifications to JP '517 made by the Examiner in the combinations would provide any advantages/benefits over the un-modified JP '517 device.

Instead, the Examiner has at best attempted to show only that the elements of the claimed invention are *individually* known without providing a *prima facie* showing of obviousness that the

combination of elements recited in the claims is known or suggested in the art. For all the foregoing reasons, it is submitted that the proposed combinations under § 103 are improper.

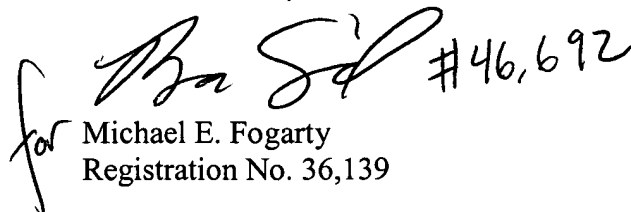
Based on all the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art.

CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,
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